

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

PATENT APPLICATION

ATTORNEY DOCKET NO. 10005002-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED

Inventor(s): Curtis C. Ballard

Confirmation No.: 2123

JUL 18 2006

Application No.: 10/007,116

Examiner: D. E. England

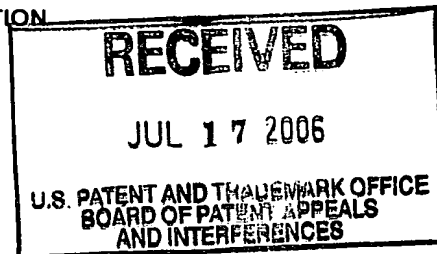
Filing Date: November 7, 2001

Group Art Unit: 2143

Technology Center 2100

Title: SYSTEM FOR AND METHOD OF AUTOMATED DEVICE DATA COLLECTION

Mail Stop Appeal Brief - Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450



TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on 05-17-2006.

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 08-2025.

☒ I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV568257900US, in an envelope addressed to: MS Board of Patent Appeals and Interferences Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450
Date of Deposit: July 13, 2006

☐ I hereby certify that this paper is being transmitted to the Patent and Trademark Office facsimile number (571) 273-8300.
Date of facsimile:

Typed Name: Susan Bloomfield

Signature: Susan Bloomfield

Respectfully submitted,

Curtis C. Ballard

By

Michael A. Papalas

Attorney/Agent for Applicant(s)

Reg No. : 40,381

Date : July 13, 2006

Telephone : (214) 855-8186

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

RECEIVED

JUL 18 2006

Technology Center 2100

In re Patent Application of:
Curtis C. Ballard

Application No.: 10/007,116

Filed: November 7, 2001

For: SYSTEM FOR AND METHOD OF
AUTOMATED DEVICE DATA COLLECTION §

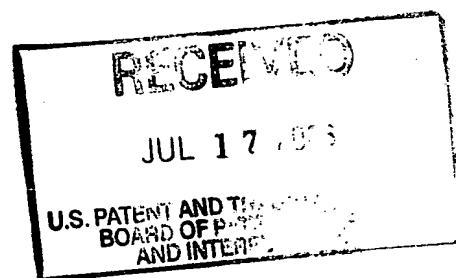
§
§
§
§
§
§
§
§

Confirmation No.: 2123

Art Unit: 2143

Examiner: D. E. England

REPLY BRIEF

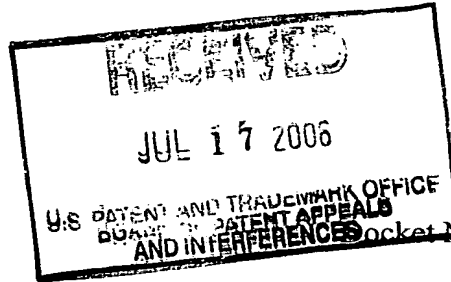


For the Appellant:

Michael A. Papalas
Reg. No. 40,381

Fulbright & Jaworski, LLP
2200 Ross Avenue, Suite 2800
Dallas, Texas 75201
Telephone: (214) 855-8186
Fax: (214) 855-8200

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400



RECEIVED
JUL 18 2006
Technology Center 2100

Case No.: 10005002-1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Curtis C. Ballard

Application No.: 10/007,116

Confirmation No.: 2123

Filed: November 7, 2001

Art Unit: 2143

For: SYSTEM FOR AND METHOD OF
AUTOMATED DEVICE DATA COLLECTION

Examiner: D. E. England

APPELLANT'S REPLY BRIEF (37 C.F.R. 41.41)

Attention: Board of Patent Appeals and Interferences
Commissioner for Patents
Washington, DC 20231

Dear Sir:

This reply brief, filed pursuant to 37. C.F.R. § 41.41, is in response to the Examiner's Response, mailed in this case on May 17, 2006. Should the Primary Examiner not find the comments contained herein persuasive, acknowledgement of receipt and entry of this Reply Brief is requested.

The fees required under § 1.17(c) and any required petition for extension of time for filing this brief and fees therefor, if any, are dealt with in the accompanying TRANSMITTAL OF REPLY BRIEF.

This brief contains these items under the following headings:

I. Reply to Examiner's Answer

A. Procedural Issues

B. Addressing the New Grounds of Rejection

C. Responses to the Rejections of Record

II. Conclusion

The final page of this brief bears the attorney's signature.

I. REPLY TO EXAMINER'S ANSWER

A. Procedural Issues

The Examiner erroneously claims that an amendment to the pending claims was filed on October 11, 2005. *See* Examiner's Answer at 2. The Appellant respectfully points out that the Response to Final Office Action filed on October 11, 2005 (hereinafter "Response to Final") contained NO AMENDMENTS to the claims. The only amendments to the pending claims made during prosecution were contained in the Appellant's Response to Office Action filed on April 26, 2005 (hereinafter "First Response"). If the Examiner believes that there were amendments other than those contained in the First Response, the Appellant respectfully asks that the Examiner to detail what those amendments were and when they were proposed.

In addition, the Examiner's Answer dedicates a significant portion to restating the Examiner's objections to the drawings. *See* Examiner's Answer pages 4-5. The Appellant respectfully points out that the appeals process is not the proper venue for these arguments, and thus, will not address these points here. If, however, the Board decides to take up this issue, the Appellant respectfully directs the Boards attention to the Appellant's First Response and subsequent Response to Final. The Appellant respectfully submits that the Examiner's objections were completely overcome by the amendments and arguments contained therein.

B. The Examiner's New Ground of Rejection

The Examiner now offers a new ground for rejecting claims 2-11 and 22, and attempts to use this new ground to overcome the inconsistencies in the Examiner's rejection of record. The Examiner now contends that the claim language "a networked device, connected to a digital network, performing a dedicated stand-alone function" contains a contradiction. Namely, that "a 'stand-alone function' could be a function performed by a computer that is not connected to a network . . . [t]herefore, it is unclear as to how one of ordinary skill in the art can 'collect information' from a device that performs a stand-alone function if what is accepted as a stand-alone is computer not connected to a network." Without conceding to the Examiner's definitions of "stand-alone function," the Appellant respectfully points out that when one reads what is required by the claim language it is obvious that no contradiction actually exists. As the Examiner points out, the claims call for a device performing a stand-alone function. However, the claims do not require that the device performing that function be a "stand-alone device." To the contrary, they expressly call for a device connected to a network. Thus using the Examiner's own definition, the claim (as the Examiner would read it) describes a function that could be performed by device that is not connected to a network being performed by a device that is connected to a network (it should be noted that the Appellant does not concede that "stand-alone function is limited to the definition proposed by the Examiner, but rather is used here to illustrate that the Examiner's argument is nonsensical on its face).

C. Responses to the Rejections of Record

The Examiner has also chosen to use the above new ground of rejection in an attempt to bolster the rejections of record for claims 4, 7, 10, 11, and 22, although the Appellant thanks the Examiner for identifying the "computer system components" of Conrad et al., U.S. Patent No. 6,892,236 (hereinafter *Conrad*), as the feature being mapped to the "networked device" of the rejected claims. According to the Examiner, however, such a comparison is suitable because the "computer system components . . . perform functions that are reported to servers." See Examiner's Answer at 13. The Examiner relies on this comparison in part because of the mistaken belief that the above new ground of rejection relieves the need for finding a device that performs a "stand-alone function." The Examiner

is incorrect. Nor is the Examiner correct when he claims that the “Appellant does not state in the claim language what the ‘function’ could be, therefore the statistical data that is collected is in direct connection to a function that is repeatedly done by the hosts or computer system components in the network.” Claim 22 does not contain any inconsistency – the claim language specifically identifies the function as a one that is “dedicated stand-alone.” The computer system components of *Conrad* can not be these devices because they perform no function that can be considered “dedicated stand-alone”; a point the Examiner seems to concede since the Examiner’s Answer does not even attempt to argue that they do.

The Examiner has also responded to the Appellant’s traversal of the obviousness rejection’s motivation. However, the Examiner’s argument misidentifies the elements needed from the constituent portions of the proposed combination. The Examiner claims that *Conrad* is being used to supply a teaching of “automatically analyzing said message” while *Moberg* is being used to supply a teaching of “analyzing said message to determine an appropriate modification of said network device.” See Examiner’s Answer at 16. However, this misstates *Moberg*’s teachings. Nothing about *Moberg* teaches “determining a modification of said network device.” *Moberg* does teach a mechanism for upgrading router software, but *Moberg* begins with fundamental assumption that the upgrade being supplied is needed. *Moberg* makes no determination at all. This is the fatal flaw in the motivation supplied by the Examiner, as *Conrad* contains no mechanism for making the determination either. Thus, substantial unspecified modification are needed to make the system of *Conrad* perform as the Examiner demands. No motivation for making those modifications exists, and even if such motivation could be found, *Moberg* does not actually provide any mechanism for determining a modification.

The Examiner also responds to the Appellant’s assertion that the motivation for combining the proposed references to reject claim 12 was inadequate. In the Answer, the Examiner states, “Examiner would like to draw the Appellant’s attention to the above replies to arguments . . . [i]n which, one can see that the combination of Conrad and Moberg can be combined to teach the prior art and the motivation as stated by the Examiner as disclosed in claim 12.” The Appellant respectfully reminds the Examiner that the sum total of the motivation supplied for combining *Conrad* and *Moberg* to reject claim 12 is “it would have

been obvious to one of ordinary skill in the art at the time of the invention was conceived to combine Moberg with Conrad because of similar reasons stated above." *See* Examiner's Answer (quoting the Final Office Action) at 12. This motivation is simply inadequate under the case law. First, the motivational statement itself is completely indefinite, as it is impossible to determine what previously stated reasoning the Examiner is attempting use. Second, even if the Appellant drafts the rejection for the Examiner and assumes the Examiner intends to use the motivation statement forwarded for the rejection of claim 11, the Appellant respectfully points out that the limitations of claim 11 are different from the limitations of claim 12, and, thus, would obviously need a different motivation.


II. CONCLUSION

Based on the foregoing remarks and arguments, Appellant respectfully submits that claims 1-20 are patentable under 35 U.S.C. § 102(b). Reversal of the rejections is courteously requested.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV568257900, in an envelope addressed to: Board of Patent Appeals and Interferences, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Date of Deposit: July 13, 2006

Typed Name: Susan Bloomfield

Signature: 

Respectfully submitted,

By 

Michael A. Papalas
Attorney/Agent for Applicant(s)
Reg. No.: 40,381

Date: July 13, 2006

Telephone No. (214) 855-8186